

REMARKS/ARGUMENTS

At the time of the Office Action dated July 20, 2009 (hereinafter, "Office Action"), claims 1-20 were pending in the present application. In the Office Action, claims 1-20 were rejected under 35 U.S.C. § 112, first paragraph. Claims 1-20 were also rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 8, 13 and 15 are being amended. Claims 7 and 12 are being canceled.

Applicants respectfully respond to the Office Action.

A. Claims 1-20 Rejected Under 35 U.S.C. § 112, First Paragraph

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph. Although Applicants disagree with this rejection, in order to advance prosecution, the claimed subject matter that was allegedly not supported by Applicants' specification is being canceled from claims 1, 8, 13 and 15. Accordingly, Applicants respectfully request that the rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph be withdrawn.

B. Claims 1-19 Rejected Under 35 U.S.C. § 103(a)

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,623,604 to Russell et al. (hereinafter, "Russell") in view of U.S. Patent No. 6,708,045 to Lieu et al. (hereinafter, "Lieu"). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a

claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

By this paper, claim 1 is being amended as indicated above. The amendments that are being made to claim 1 are supported by at least page 8, lines 14-18 and page 9, lines 2-3 of Applicants’ specification, Figure 5 of Applicants’ drawings, and original claim 7.

Applicants respectfully submit that the combination of Russell and Lieu does not teach or suggest that “the adapter ... sends ... an identification of the electronic device to the provider computer,” as recited in amended claim 1.

Figure 1 of Russell shows a “Network Expansion Board (‘NEB’) 2 coupled to a printer 4.... The NEB 2 is coupled to the LAN bus 6.... Also coupled to the LAN 6 may be ... PC 14 (which ... acts as the network administrator...)....” (Russell, col. 4, lines 39-47.) As best understood, it appears that the Examiner is interpreting the NEB 2 in Russell as the “communications adapter” in claim 1, the printer 4 in Russell as the “electronic device” in claim 1, and the network administrator’s PC 14 in Russell as the “provider computer” in claim 1. (If Applicants have misunderstood the Examiner’s interpretation, Applicants respectfully request that the Examiner provide clarification in the next Office Action.)

The Office Action asserts that “Russell teaches ... the adapter ... send[s] an identification of the electronic device to the provider computer [col. 8, lines 45-50].” (Office Action, page 6.) Applicants respectfully disagree. The cited portion of Russell states that “the printer 4 ... provide[s] a great deal of status (and other) information from the printer 4 to the LAN 6 via the NEB.” However, the cited portion of Russell does not teach or suggest anything about “an identification of the [printer 4].” Russell’s reference to “status (and other) information” does not teach or suggest “an identification of the [printer 4].”

Moreover, even if Russell’s reference to “status (and other) information” were interpreted as suggesting “an identification of the [printer 4]” (which Applicants do not concede), Russell does not teach or suggest that the “status (and other) information” is sent “after the [NEB 2] is connected to a communication port of the [printer 4] but before the new data is received,” as required by amended

claim 1.

Figure 14 of Russell illustrates “how a network administrator can ... initialize and ... configure, and later ... reconfigure, both NEB 2 and printer 4 in which the NEB [2] resides.” (Russell, col. 33, lines 27-30.) Russell states that each NEB 2 sends to the administrator’s PC 14 the “server type, server name and a unique socket number by which each NEB can be accessed directly, and an indication of whether or not the NEB requires configuration.” (Russell, col. 33, lines 35-37.) However, at no point does Russell teach or suggest that “the [NEB 2] ... sends ... an identification of the [printer 4] to the [administrator’s PC 14],” as required by amended claim 1.

Lieu does not make up for the deficiencies of Russell. The Office Action does not assert that Lieu teaches or suggests an “adapter” that “sends ... an identification of the electronic device to the provider computer” at any time, and certainly not that “an identification of the electronic device” is sent “after the adapter is connected to a communication port of the electronic device but before the new data is received,” as required by amended claim 1. Nor can Applicants find any part of Lieu that teaches or suggests this claimed subject matter. Thus, the combination of Russell and Lieu does not teach or suggest all of the subject matter of amended claim 1. Applicants respectfully submit that amended claim 1 is therefore allowable. Claims 2-6 and 16-19 depend from claim 1, and are therefore allowable for at least the same reasons. Claim 7 is being canceled.

Claim 8 is being amended similarly to claim 1. In particular, claim 8 is being amended to recite that “the adapter sends ... the identification of the electronic device to the provider computer after the adapter is connected to the communications port of the electronic device and before the new instructions are received.” As discussed above, the combination of Russell and Lieu does not teach or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that amended claim 8 is allowable. Claims 9-11 depend from claim 8, and are therefore allowable for at least the same reasons. Claim 12 is being canceled.

In addition, Applicants present the following additional reasons why claim 10 is allowable. Applicants respectfully submit that the combination of Russell and Lieu does not teach or suggest that “the new instructions include an object representation of the electronic device,” as recited in

claim 10 (emphasis added). In fact, an electronic search for the term “object” in both Russell and Lieu did not yield any results.

Unfortunately, the discussion of claim 10 on page 6 of the Office Action does not even mention the limitation that “the new instructions include an object representation of the electronic device,” as recited in claim 10 (emphasis added). The Office Action discusses “services that reflect a function” and “functions that provide access to a function,” but no mention is made of an “object representation of the electronic device,” as recited in claim 10. Because the Examiner has not addressed every limitation in claim 10, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness. As indicated above, Applicants respectfully submit that the combination of Russell and Lieu does not teach or suggest that “the new instructions include an object representation of the electronic device,” as recited in claim 10. Therefore, Applicants respectfully submit that claim 10 is allowable. If the Examiner disagrees and maintains the rejection, Applicants respectfully request that the Examiner specifically identify the part of Russell and/or Lieu that teaches or suggests that “the new instructions include an object representation of the electronic device,” as recited in claim 10 (emphasis added).

Claim 13 is being amended similarly to claim 1. In particular, claim 13 is being amended to recite that the “identification of the electronic device [is] sent to the provider computer after the adapter is connected to the communication port of the electronic device and before the new instructions are received.” As discussed above, the combination of Russell and Lieu does not teach or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that amended claim 13 is allowable. Claim 14 depends from claim 13, and is therefore allowable for at least the same reasons.

Claim 15 is being amended similarly to claim 1. In particular, claim 15 is being amended to recite that “the identification of the electronic device [is] sent to the provider computer after the adapter is connected to a communication port of the electronic device and before the new instructions are received.” As discussed above, the combination of Russell and Lieu does not teach

Appl. No. 10/784,485
Amdt. dated October 20, 2009
Reply to Office Action of July 20, 2009

or suggest this claimed subject matter. Accordingly, Applicants respectfully submit that amended claim 15 is allowable.

C. Claim 20 Rejected Under 35 U.S.C. § 103(a)

Claim 20 stand rejected under 35 U.S.C. § 103(a) based on Russell in view of Lieu, and further in view of U.S. Patent No 6,074,434 to Cole et al. (hereinafter, "Cole"). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

Claim 20 depends from claim 1. As discussed above, Applicants respectfully submit that amended claim 1 is allowable. Accordingly, Applicants respectfully submit that claim 20 is allowable for at least the same reasons as presented above in connection with amended claim 1.

D. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant

Date: October 20, 2009

AUSTIN RAPP & HARDMAN
170 South Main Street, Suite 735
Salt Lake City, Utah 84101
Telephone: (801) 537-1700